

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID FARROW

Appeal No. 1996-3536
Application No. 08/509,006¹

ON BRIEF

Before STAAB, NASE, and GONZALES, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1 through 17 and 21 through 23, which are all of the claims pending in this application.

¹ Application for patent filed July 31, 1995. According to the appellant, the application is a continuation of Application No. 08/163,745, filed December 7, 1993, now abandoned.

Appeal No. 1996-3536
Application No. 08/509,006

We REVERSE.

BACKGROUND

The appellant's invention relates to a tamperproof label assembly. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

Claims 1 through 17 and 21 through 23 stand rejected under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 19, mailed May 20, 1996) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 18, filed April 19, 1996) and reply brief

Appeal No. 1996-3536
Application No. 08/509,006

Page 4

(Paper No. 20, filed July 2, 1996) for the appellant's
arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to support a rejection under the first paragraph of 35 U.S.C. § 112. Accordingly, we will not sustain the examiner's rejection of claims 1 through 17 and 21 through 23 under 35 U.S.C. § 112, first paragraph. Our reasoning for this determination follows.

The examiner's complete statement of the ground of rejection (answer, pp. 2-3) is as follows:

The following ground(s) of rejection are applicable to the appealed claims.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

Appellant is attempting by preliminary amendment to delete the term "CFB" from the specification and claims.

The appellant argues (brief, p. 4) that the claims under appeal "are not properly rejected . . . for lacking support in

the specification." The appellant then specifies (brief, pp. 4-10) where support in the specification can be found for the claimed subject matter.

It is well settled that the written description and enablement requirements set forth in the first paragraph of 35 U.S.C. § 112 are separate and distinct from one another and have different tests. See In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984); In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977); and In re Moore, 439 F.2d 1232, 1235-36, 169 USPQ 236, 239 (CCPA 1971). Since the examiner's basis for the rejection on appeal is based on a lack of support for the invention as is now claimed, it is not entirely clear to us exactly which requirement the examiner's rejection is based upon. Accordingly, we will review the claims as having been rejected under both the written description and enablement requirements.

Written description requirement

The test for determining compliance with the written description requirement is whether the disclosure of the

application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The description requirement is that the invention claimed be described in the specification as filed, and a rejection thereunder is fully defeated by a specification which describes the invention in the same terms as the claims. See In re Bowen, 492 F.2d 859, 864, 181 USPQ 48, 52 (CCPA 1974). Furthermore, where an original claim is identical in language to the subject matter now being claimed, nothing more is required for compliance with the description requirement of the first paragraph of § 112. See In re Gardner, 475 F.2d 1389, 1391, 177 USPQ 396, 397, supplemental opinion, 480 F.2d 879, 879-80, 178 USPQ 149 (CCPA 1973) and In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973).

The examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976); Ex parte Sorenson, 3 USPQ2d 1462, 1463 (Bd. Pat. App. & Int. 1987).

In our view, the examiner has not met this initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the appellant's disclosure a description of the invention defined by the claims. In this regard, we note that the examiner has not (1) identified the claim limitation not described; and (2) provided reasons why persons skilled in the art at the time the application was filed would not have recognized the description of the claimed limitations in the disclosure of the application as filed.

We have reviewed the specific concern stated by the examiner in this rejection (i.e., the deletion of "CFB"), but find nothing therein which supports a rejection based upon the written description requirement of 35 U.S.C. § 112, first

paragraph. In addition, for the reasons set forth by the appellant (brief, pp. 4-10), we have determined that these claims do comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

Enablement requirement

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the

enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). As stated by the court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is

inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." In re Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

Thus, the threshold step in resolving this issue as set forth supra is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement. Clearly, the examiner has not met this burden. Moreover, it is our opinion that the claims do comply with the enablement requirement of 35 U.S.C. § 112, first paragraph.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 17 and 21 through 23 under 35 U.S.C. § 112, first paragraph, is reversed.

REVERSED

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
)	
)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
JOHN F. GONZALES)	
Administrative Patent Judge)	

Appeal No. 1996-3536
Application No. 08/509,006

Page 13

NIXON AND VANDERHYE
8TH FLOOR
1100 NORTH GLEBE ROAD
ARLINGTON, VA 22201

APPEAL NO. 1996-3536 - JUDGE NASE
APPLICATION NO. 08/509,006

APJ NASE

APJ STAAB

APJ GONZALES

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 01 Apr 99

FINAL TYPED: